

applicant wishes to respectfully call the Examiner's attention to page 20, lines 16-26 where the administration of a major amount of 1,2 dipalmitoyl-sn-3-glycerophosphoryl choline in admixture with a minor amount of hexadecanol is described. The substance as described was administered directly to the bronchi (aveolar spaces) of premature lambs. As stated on p. 20 premature lambs lacking endogenous lung surfactant exhibited no signs of respiratory distress syndrome when they received the method of treatment described in claims 8 and 9.

It is unnecessary to describe the exact method of administering the surfactant since procedures for introducing substances into the lungs of mammals are part of the common knowledge of anyone possessing ordinary skill in this field. When test methods in the field of the patent are so well known that reference to them is unnecessary to enable those working in the field to follow the teaching of the patent, "even complete silence on dosage and method of administration suffices to meet the "how to use" requirement of 35 U.S.C. 112." Carter-Wallace, Inc. v Davis Edwards Pharmácia Corp. 173 USPQ 65 (1972).

The basis of the Examiner's rejection is not understood since a careful reading of the description of the invention beginning with Example I on page 13 of the application and emphasizing lines 16-26 on page 20 would enable any person skilled in the art to use the method expounded in claims 8 and 9. The rejection of claims 8 and 9 on such a basis therefore should be withdrawn.

Claims 1-7 stand rejected under 35 U.S.C. 112 as not properly defining the alleged invention. The Examiner is of the view that the recitation "fatty alcohol" is undeterminable in scope and makes the claims indefinite. Applicant wishes to point out that, on the contrary, fatty alcohols are determinable in scope. As defined, for example, by The Condensed Chemical Dictionary (7th ed) Reinhold Publishing Corporation, fatty alcohols are limited to primary alcohols from C₈ to C₂₀ and are usually straight chain alcohols. Since applicant's discovery is a pioneering invention in its field applicant should be allowed to use

the term "fatty alcohol" in its broadest sense. Applicant does not believe the patent should be limited to only those fatty alcohols which the applicant has had the opportunity to experimentally test. As the court stated in In re Goffe 191 USPQ 429, (1976) and reiterated in In re Johnson and Farnham, 194 USPQ 187, (1977).

"[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts."

The applicant believes that this rejection is not well taken. In any event even if claim 1 is rejected as indefinite, claims 2,3 and 4 should be allowable in that they narrowly prescribe the component alcohols. Claim 2 restricts the fatty alcohol to approximately 14 to 18 carbon atoms, and claims 3 and 4 specify the alcohols hexadecanol and oleic, respectively.

Claims 1-5, and 7 are also rejected under 35 U.S.C. 112 as not being supported by the specification in that they fail to show the disclosed ratios and proportions. Regardless of the merit of rejecting claims 1-4 and 7 on this ground, such a rejection doesn't apply to claim 5 which in fact states a major to minor ratio. Examiner's attention is directed to p. 13, lines 9-11 of the specification which describe the alcohol component as constituting a minor portion of the surfactant composition. A more limited ratio is not required. If an applicant seeking a chemical composition patent claims a range of proportions for various elements thereof, it is only necessary to demonstrate the criticality of a particular range when such criticality is essential to nonobviousness. In re Kröekel and Pfäff 183 USPQ 610 (1974).

In addition to claim 5, claims 1-4 and 7 should also be accepted. In Ex parte Wetterhölm, 130 USPQ 239, (1960) the Patent Office Board of Appeals did not sustain

the rejection of a claim based on the failure to state a percentage of a compound. The Board stated that it read the claim as calling only for the compound so that a recitation of the percentages would be redundant. The Board found that the essential feature of the invention was the particular new compound utilized and did not regard the relative amount of the compound in the composition of particular claims to be a critical feature. Nor did it see that the selection of useful percentages would be beyond the ordinary skill of the art. Therefore, in a pioneering invention such as this, it is sufficient that applicant shows a range of workable percentages in the specification. Applicant should not be forced to confine himself to specific ratios and proportions. He is entitled to claims with a much broader range. It is the function of the specification not the claims, to set forth the "practical limits of the operation" of an invention, In re Rainier, 134 USPQ 343, (1962). Applicant believes that claims 1-5 and 7 are improperly rejected and should be accepted.

In view of the above statements, the Examiner is earnestly requested to reconsider the allowability of claims 1-9. Favorable action in this regard is earnestly solicited.

Respectfully submitted,


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